

## **RESPONSE TO OFFICE ACTION**

### **A. Status of the Claims**

Claims 1-24 were filed and the claims amended herein. Support for the amendments is found in the claims as filed. Reconsideration of the claims is respectfully requested.

### **B. Specification Objection**

The specification is objected to for reciting a U.S. application number. In response it is noted that the application number has been deleted and thus the objection is now moot.

The Action also states that the listing of references in the specification is not a proper IDS. In response it is noted that Applicants have already submitted in the case.

### **C. Claim Objections**

(1) Claim 21 is objected to for a typo. This has been corrected and therefore the objection is moot.

(2) It is stated that claims 6 and 8 are substantial duplicates. Applicants respectfully traverse as claim 8 is in a product by process format, unlike claim 6, and is thus of different scope than claim 6. In particular, claim 8 requires the process of claim 7, which involved introduction of a male sterility gene. This method is not required for the production of the plant of claim 6, which could inherit a male sterility gene from a progenitor without the process of claim 7. The claims are therefore not duplicate and removal of the rejection is thus respectfully requested.

**C. Rejection of Claims Under 35 U.S.C. §112, Second Paragraph**

The Action rejects the claims under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out the subject matter which Applicants regard as the invention. The individual rejections and Applicants' responses thereto are set forth below.

(1) The Action rejects claims 1-24 for recitation of "LH360" and including blank lines in place of ATCC Accession numbers. In response, it is noted that the claims will be amended to insert the corresponding accession numbers for a deposit of seed of LH360. The rejection is thus believed moot and removal thereof is respectfully requested.

(2) In regard to claim 8 it is stated that the claim inadvertently depends from claim 6. Applicants note that this has been corrected to refer to claim 7 and thus the objection is now moot.

(3) In claims 16 and 21 it is stated that "male sterility and restoration of male fertility" is indefinite as it is unclear if both traits are intended. In response, Applicants note that a comma has been placed after "male fertility" to clarify that two different traits are being referred to. Specifically, it is well known in the art of plant breeding that both male sterility and male fertility restoring genes may be used for breeding of corn varieties. For example, male fertility restorer genes are frequently used to permit the preservation of otherwise male sterile breeding lines. It is therefore believed that the rejection is now moot and removal thereof is thus respectfully requested.

(4) It is next stated that in claim 19 the recitation, "substantially" in line 5 of part (e) renders the claim indefinite as being a relative term with no definite meaning. In

response, Applicants note that the claim has been amended to specify that in step (e) backcrossing according to the repeating steps of (c) and (d) is carried out for at least three additional generations, and further to clarify that “both alleles at essentially all of the loci consist essentially of the allele found at the same locus in corn variety LH360.” The former amendments specifies that sufficient backcrossing occurs that the latter limitation will necessarily share a given degree of identity with the alleles in LH360. In addition, the latter limitation is consistent with the definition of “Converted (Conversion) Plant” given in the specification, which is also a well known term.

Finally, there is no lack of comparative basis because the relevant limitation states in full that “both alleles at essentially all of the loci consist essentially of the allele *found at the same locus in corn variety LH360*” (emphasis added). Thus it is clear that both loci are the same with respect to the corresponding loci in variety LH360. There is therefore further no lack of comparative basis.

In view of the foregoing, the limitations of the claim are fully definite to those of skill in the art when taken in view of the specification as required under the statute. Withdrawal of the rejection is thus respectfully requested.

(5) Claim 20 is rejected as unclear regarding “a corn genome.” In response it is noted that the claim has been amended herein and that the rejection is believed moot. Removal of the rejection is thus respectfully requested.

#### **E. Rejection of Claims Under 35 U.S.C. §112, First Paragraph - Enablement**

The Action rejects claims 1-24 under 35 U.S.C. §112, first paragraph, for lack of a seed deposit. In response, Applicant notes that a deposit of 2,500 seeds of the claimed variety will be made with the ATCC in accordance with all of the relevant rules. A

declaration certifying that the deposit meets the criteria set forth in 37 C.F.R. §1.801-1.809 will be provided and the claims amended to recite the corresponding accession number. The specification will also be amended to include the accession number of the deposit and the date of deposit.

In view of the foregoing, removal of the rejection is respectfully requested.

**E. Conclusion**

This is submitted to be a complete response to the referenced Office Action. In conclusion, Applicant submits that, in light of the foregoing remarks, the present case is in condition for allowance and such favorable action is respectfully requested.

The Examiner is invited to contact the undersigned at (512) 536-3085 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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Date: June 4, 2007